

REMARKS

By this Amendment, Applicants cancel claims 1, 7 and 18, without prejudice or disclaimer of the subject matter therein, amend claims 2, 3, 5, 6, 8, 9, 11-17, 19, 20, 23 and 25-27, and add new claims 28-39. Claims 2-6, 8-17 and 19-39 are therefore pending in this application with claim 20 being the sole independent claim. Support for the claim amendments and new claims can be found in the originally-filed specification, drawings, and claims. No new matter has been introduced.

In the Office Action of October 18, 2004,¹ claim 11 was objected to for informalities; claims 1-12, 15-19 and 21-27 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application Publication No. 2001/0037191 to *Furuta et al.* (“*Furuta*”); claims 1-5, 7, 9, 12, 15-17, 21, 22, 26 and 27 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,792,401 to *Nigro et al.* (“*Nigro*”); claims 13, 14 and 20 were rejected under 35 U.S.C. § 103(a) as unpatentable over *Furuta*; and claim 20 was rejected under 35 U.S.C § 103(a) as unpatentable over *Furuta* in view of PCT International Application Publication No. WO 97/29441 (“*Bechara*”). Applicants address the objection and rejections below.

Objection to claim 11

In the Office Action, the Examiner noted that claim 11 does not end with a period. By this Amendment, Applicants amend claim 11 to correct this informality. Applicants therefore request withdrawal of the objection.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether or not any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Section 102(e) rejection of claims 1-12, 15-19 and 21-27 based on *Furuta*

The rejection of claims 1, 7 and 18 is rendered moot by the cancellation of those claims. Further, Applicants traverse the rejection of claims 2-6, 8-12, 15-17, 19 and 21-27 under 35 U.S.C. § 102(e) because *Furuta* fails to anticipate those claims. In order to properly anticipate Applicants' claimed invention under 35 U.S.C. § 102, each and every element of the claim at issue must be found, either expressly described or under principles of inherency, in a single prior art reference.

Each of claims 2-6, 8-12, 15-17, 19 and 21-27 depends (directly or indirectly) upon claim 20, which has been amended and rewritten in independent form. Independent claim 20, and thus dependent claims 2-6, 8-12, 15-17, 19 and 21-27, recites, among other aspects:

analyzing the at least one external body condition via the three-dimensional image; and proposing to the subject an aesthetic feature for affecting the at least one external body condition based, at least in part, on the analyzing of the external body condition.

Furuta is directed to providing a beauty simulation (Abstract), and fails to disclose or otherwise suggest at least the “proposing” feature recited in claim 20. Indeed, the Examiner acknowledged that *Furuta* fails to disclose either “proposing a beauty product to the subject based, at least in part, on the analyzing of [an external body condition]” or “proposing a product based on the analysis of the face model” (Office Action “OA” at 6).

Because *Furuta* does not teach each and every element recited in claim 20 and required by dependent claims 2-6, 8-12, 15-17, 19 and 21-27, as a matter of law, the reference cannot anticipate those claims. As such, the rejection of claims 2-6, 8-12, 15-17, 19 and 21-27 under 35 U.S.C. §102(e) based on *Furuta* should be withdrawn.

Section 102(e) rejection of claims 1-5, 7, 9, 12, 15-17, 21, 22, 26 and 27 based on *Nigro*

The rejection of claims 1 and 7 is rendered moot by the cancellation of those claims. Further, Applicants traverse the rejection of claims 2-5, 9, 12, 15-17, 21, 22, 26 and 27 under 35 U.S.C. § 102(e) because *Nigro* fails to anticipate the claims.

Nigro is directed to an optical imaging system (Abstract). Although, as the Examiner noted, *Nigro* mentions allowing a customer to “view and orient his or her real-time image, wear a sales item on a virtual personal model, and order selected sales [items] . . . ,” *Nigro* does not disclose or otherwise suggest the above-noted “proposing” feature of claim 20, which also is required by dependent claims 2-5, 9, 12, 15-17, 21, 22, 26 and 27. Indeed, the Examiner has not asserted that *Nigro* discloses such a feature. (OA at p. 5).

Because *Nigro* does not teach each and every element recited in claim 20 and required by dependent claims 2-5, 9, 12, 15-17, 21, 22, 26 and 27, as a matter of law, the reference cannot anticipate those claims. The rejection of claims 2-5, 9, 12, 15-17, 21, 22, 26 and 27 under 35 U.S.C. §102(e) based on *Nigro* should therefore be withdrawn.

Section 103(a) rejection of claims 13, 14 and 20 based on *Furuta*

Applicants traverse the rejection of claims 13, 14 and 20 because a case for *prima facie* obviousness has not been established. To establish *prima facie* obviousness under 35 U.S.C. § 103(a), three requirements must be met. First, the applied references, taken alone or in combination, must teach or suggest each and every element recited in the claims. *See* M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the reference(s) or in the knowledge generally available to one of ordinary skill in the art, to combine or modify the reference(s) in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be

found in the prior art, and not be based on applicant's disclosure." M.P.E.P. § 2143 (8th ed. 2001).

With regard to independent claim 20, as discussed above and acknowledged by the Examiner, *Furuta* does not teach or suggest at least, *inter alia*, "proposing to the subject an aesthetic feature for affecting the at least one external body condition based, at least in part, on the analyzing of the external body condition." As noted above, *Furuta* is directed to providing a beauty simulation (Abstract). *Furuta* discloses generating a facial image using captured images of a user. The Examiner alleged that *Furuta* discusses "preparing brochures custom-tailored to the attributes of each group of users and [sending] . . . brochures with different contents to each" (Office Action "OA" at 6; *Furuta*, ¶ 0082).

Furuta's disclosure of preparing and sending brochures, however, does not teach or suggest the above-quoted aspect of claim 20 and required by dependent claims 13 and 14. According to *Furuta*, the brochures could include product information (¶ 0082). Even assuming *arguendo* *Furuta*'s brochures were construed as beauty product proposals, *Furuta* does not disclose that the brochures are based on an analysis of an external body condition. Instead, *Furuta* describes that the brochures are prepared based on group attributes, which are not disclosed as including or reflecting external body condition analyses.

Furthermore, *Furuta*'s disclosure, noted by the Examiner, of analyzing the facial skin and light and dark areas to evaluate beauty and apparent age (OA at 4; *Furuta*, ¶¶ 0043-44) does not teach or suggest analyzing the external body condition via the three-dimensional image, and proposing to the subject an aesthetic feature for affecting the at least one external body condition based, at least in part, on the analyzing of the external body condition as set forth in claim 20.

To allegedly provide support for the hypothetical modification of *Furuta*, the Examiner alleged that “[a]t a cosmetics store the salesperson generally proposes various types of products, and *Furuta* is interested in simulating this experience over the internet, thus it would be obvious to propose a product based on the analysis in order to increase sales” (OA at 6). The Examiner has not established a *prima facie* conclusion of obviousness with respect to claim 20.

Determinations of obviousness must be supported by evidence on the record. *See In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (finding that the factual determinations central to the issue of patentability, including conclusions of obviousness by the Board, must be supported by “substantial evidence”). Further, the desire to combine or modify references must be proved with “substantial evidence” that is a result of a “thorough and searching” factual inquiry. *See In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52).

The Examiner’s allegation that it would have been obvious to propose a beauty product based on an analysis to increase sales is merely conclusory by and is unsupported by any evidence of record whatsoever. Further, the Office Action does not establish that a skilled artisan considering *Furuta*, and not having the benefit of Applicants’ disclosure, would have modified the reference in a manner resulting in Applicants’ claimed combination.

Applicants call attention to M.P.E.P. § 2143.01, which makes clear that: “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination” (citations omitted). The Office Action does not show that the cited art “suggests the desirability” of a modification resulting in the invention defined by claim 20. That is, the Examiner does not show that *Furuta*, or any other piece of evidence, suggests the desirability of the “proposing” aspect of claim 20.

Moreover, the Examiner has failed to establish a reasonable expectation of success in modifying *Furuta* in the manner set forth in the Office Action. That is, the Examiner appears to allege that skilled artisans would look to the activity of a salesperson proposing products at a cosmetics store in order to modify *Furuta* to include the “proposing” aspect recited in claim 20. However, the Examiner has not shown that skilled artisans would understand how such product proposal could be implemented in the internet based system of *Furuta*, which requires entirely different operation than a salesperson at a cosmetics store. The Examiner has not shown that skilled artisans would have thought such “proposing” on the internet based system of *Furuta* would reasonably succeed or how *Furuta* would need to be modified to include such a “proposing” feature based on such proposing being performed by a salesperson at a cosmetics store. *Furuta* is related to an entirely different field (i.e., a computer based system) and operates under entirely different principles than activities by salespersons in cosmetics stores.

For at least the foregoing reasons, a *prima facie* case of obviousness based on *Furuta* has not been established, and the rejection of claim 20 under 35 U.S.C. § 103(a) should be withdrawn. The rejection of claims 13 and 14 should be withdrawn as well, for at least the same reasons as those presented above in connection with claim 20.

Section 103(a) rejection of claim 20 based on *Furuta* and *Bechara*

Applicants traverse the § 103(a) rejection of claim 20 because a case for *prima facie* obviousness has not been established based on *Furuta* and *Bechara*.

As explained above, *Furuta* does not teach or suggest the “proposing” feature of claim 20. *Bechara* does not cure *Furuta*’s deficiencies. *Bechara* is directed to automating activity of an optical shop (Abstract). The Examiner alleged that *Bechara* discloses “according to the customer’s cosmetic preferences and the features of his face, the operating program presents a showcase with suggestions of best fit eyewear products” (OA at 7). According to *Bechara*,

eyewear products are suggested based on user preferences as well as the “format and dimensions of the face” (page 13). Presenting eyewear products according to preferences and dimensions, as disclosed by *Bechara*, does not teach or suggest, *inter alia*, “analyzing the external body condition via the three-dimensional image, [and] proposing to the subject an aesthetic feature for affecting the at least one external body condition based, at least in part, on the analyzing of the external body condition.”

Even assuming *arguendo* that suggesting eyewear products based on preferences and facial dimensions, as described by *Bechara*, were consistent with proposing an aesthetic feature based, at least in part, on analyzing an external body condition (to which Applicants do not acquiesce), *Bechara* nonetheless fails to disclose “proposing to the subject an aesthetic feature *for affecting the external body condition . . .*” as claimed. That is, *Bechara* does not disclose proposing eyewear products for affecting an analyzed external body condition, even if facial dimensions were considered as an “external body condition.”

For at least the foregoing reasons, neither *Furuta* nor *Bechara*, whether taken alone or in combination, teaches or suggests each and every element recited in claim 20 and a case for *prima facie* obviousness has thus not been established.

In addition, *prima facie* obviousness has not been established with respect to claim 20 because the required motivation for combining *Furuta* and *Bechara* is lacking. The Examiner has not shown that a skilled artisan considering *Furuta* and *Bechara*, and not having the benefit of Applicants’ disclosure, would have been motivated to combine the references in a manner resulting in Applicants’ claimed combination. The Examiner’s allegation that a skilled artisan would have combined the references to “allow the user to find desired products quicker and thus improve their shopping experience” (OA at p. 7) is not properly supported by evidence and does

not show that a skilled artisan would have modified the references to include the above-mentioned features of claim 20.

Again, Applicants call attention to M.P.E.P. § 2143.01, which makes clear that: “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination” (citations omitted). The Office Action does not show that the cited art “suggests the desirability” of a combination resulting in the invention defined by claim 20.

At least because the applied art does not teach or suggest each and every feature of claim 20 and the requisite motivation to modify the reference is lacking, *prima facie* obviousness has not been established and the § 103(a) rejection should be withdrawn. Applicants thus request withdrawal of the § 103(a) rejection based on *Furuta* and *Bechara* and the timely allowance of claim 20.

Each of new claims 28-37 depends directly or indirectly from independent claim 20. Applicants submit that these new claims are allowable over the applied art at least by virtue of such dependency. Further, the applied art fails to teach or suggest various features recited in at least some of new claims 28-37.

Conclusion

In light of the foregoing, Applicants request the withdrawal of the outstanding claim objection and rejections and the timely allowance of pending claims 2-6, 8-17, and 19-39.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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